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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/397,782 09/16/99 CONRAD

C INGA.004/CIP

EXAMINER

HM12/0615

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MARTINELLI, J

ART UNIT

PAPER NUMBER

1633

DATE MAILED:

06/15/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/397,782

Applicant(s)

CONRAD, CHARLES A.

Examiner

James Martinell

Art Unit

1633

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 23 April 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_

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The indicated allowability of claim 7 is withdrawn in view of the newly discovered reference(s) to Mirochnitchenko et al (J. Biol. Chem. 269: 2380 (1994)), Miyata et al (U.S. 5,436,141), Miyata et al (EP 0 532 380), and Inouye et al (EP 0 562 206). Rejections based on the newly cited reference(s) follow.

This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

The abstract of the disclosure does not commence on a separate sheet in accordance with 37 CFR 1.52(b)(1). A new abstract of the disclosure is required and must be presented on a separate sheet, apart from any other text.

The disclosure is objected to because of the following informalities.

- (a) The application proceeds from page 31 (claims 1-7) to page 33 (Table I), so page 32 (if there is supposed to be a page 32) is missing.
- (b) Table I does not recite SEQ ID NOs as required (see 37 CFR § 1.821(d)).
- (c) The status of each of the parent applications mentioned in the first sentence of the application should be updated (*e.g.*, SN 08/236,504 has no status associated with it).
- (d) All of the parent application information is to occur in one sentence (the first sentence) of the application. See MPEP 201.11.

Appropriate correction is required.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

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Claims 1-7 are rejected under 35 U.S.C. 102(a) as being clearly anticipated by any one of Mirochnitchenko et al (J. Biol. Chem. 269: 2380 (1994)), Miyata et al (EP 0 532 380), or Inouye et al (EP 0 562 206). Each of the references discloses vectors for the *in vivo* production of single stranded antisense DNA utilizing a vector that contains a template for antisense DNA flanked by inverted repeats and employing a cloned RT gene for production of reverse transcriptase and thus, single stranded DNA. For example, see Mirochnitchenko et al "RESULTS AND DISCUSSION" section, Miyata et al, pages 4-10, and Inouye et al, pages 5-14.

Claims 1-7 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by, Miyata et al (U.S. 5,436,141). The reference discloses vectors for the *in vivo* production of single stranded antisense DNA utilizing a vector that contains a template for antisense DNA flanked by inverted repeats and employing a cloned RT gene for production of reverse transcriptase and thus, single stranded DNA. For example, see columns 5-14 and claims 1-45.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Martinell whose telephone number is (703) 308-0296. The examiner can normally be reached on Tuesdays through Thursdays and Saturdays from 8:00 A.M. to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah R. Clark, can be reached on (703) 305-4051. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

  
JAMES MARTINELL, Ph.D.  
SENIOR LEVEL EXAMINER